

REMARKS / ARGUMENTS

The present application includes pending claims 1-64, all of which have been rejected. Claims 1-7, 11, 13-14, 16, 20-22, 24-26, 28-31, 33-45, 49, 51-52, 54-57 and 59-64 have been amended to further clarify the language used in these claims and to further prosecution of the present application. The Applicant points out that the amendments to the claims may find support in, for example, paragraph 0046 and in Fig. 1 of the present application. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1-6, 8, 10-14, 17-18, 20-21, and 25-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0139180, issued to White, et al. (hereinafter, White). Claims 7, 9, 15-16, 19, 22-24, and 27-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over White as applied to claims 1-6, 8, 10-14, 17-18, 20-21, and 25-26 above, and further in view of U.S. Patent No. 6,845,398, issued to Galensky, et al. (hereinafter, Galensky). The Applicant respectfully traverses these rejections at least based on the following remarks.

REJECTION UNDER 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure, Rev. 6, Sep. 2007 ("MPEP") states the following:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

See the MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" (citing *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007)). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

I. White Does Not Render Claims 1-6, 8, 10-14, 17-18, 20-21, 25-26, 39-44, 46, 48-52 and 55-64 Unpatentable

The Applicant first turns to the rejection of claims 1-6, 8, 10-14, 17-18, 20-21, 25-26, 39-44, 46, 48-52 and 55-64 as being unpatentable over White.

A. Independent Claims 1, 20 and 39

With regard to the rejection of independent claim 1 under 103(a), the Applicant submits that White does not disclose or suggest at least the limitation of **“only specific ones of the media files are accessed and downloaded by the at least one client based on a particular location of the at least one client,”** as recited by the Applicant in independent claim 1. The Final Office Action states the following:

“With regard to claim 1, White discloses a system for wirelessly playing media files, the system comprising:

a central server having a memory for storing the media files (White: Figure 2, 110);

a station connected to the central server (White: Figure 2, 120);

at least one client, the client capable of accessing and downloading the files by wirelessly communicating with the server via the station from a plurality of remote locations from the station and the server (White: Figure 2, 130 and Paragraph [0014]. The mobile media server (130) is capable of accessing and downloading the files through the wireless hub anywhere within range of the wireless hub. As the mobile media server can be anywhere within range of the hub, this constitutes a plurality of locations.), wherein the media files are accessed and downloaded by the at least one client based on a particular location of the at least one, client (White: Abstract. The media files are only downloaded when the client is in range of the server, meaning that the access and download is based on a particular location.).”

See Final Office Action at pages 2-3. The Examiner relies for support on White’s Abstract and in FIG. 2, and equates Applicant’s “client” to White’s mobile media server 130. The Applicant points out that even though White discloses that the mobile media server 130 can access and download files through the wireless hub 120 within range of the wireless hub 120, White, however, still does not disclose or suggest that **only**

specific ones of the media files within the home media server 110 are accessed and downloaded **based on a particular location of the mobile media server** 130. This is evidenced by White in the Abstract, which states the following:

“In operation, when the automobile carrying the mobile media server comes within an operational range of the wireless hub, **a first set of media residing on the home media server and a second set of media residing on the mobile media server are synchronized.** Preferably, synchronization occurs automatically once the mobile media server is within range of the wireless hub. In this manner, two-way **synchronization provides the same media on both the home media server and the mobile media server**”

See White at the Abstract. White does not teach or suggest that the two way synchronization **only** provides **specific media files** within the home media server 110 **or** in the mobile media server 130 are accessible for downloading. On the contrary, White discloses clearly a two way synchronization, which automatically provides “**the same media on both the home media server 110 and the mobile media server** 130”, which is non-specific. In other words, White does not disclose any restriction for the accessibility of the available media files for downloading.

Based on the foregoing rationale, the Applicant maintains that White does not disclose or suggest at least the limitation of “**only specific ones of the media files are accessed and downloaded** by the at least one client **based on a particular location of the at least one client,**” as recited by the Applicant in independent claim 1.

The Applicant submits that claim 1 is allowable. Independent claims 20 and 39 are similar in many respects to the method disclosed in independent claim 1.

Therefore, the Applicant submits that independent claims 20 and 39 are also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

B. Rejection of Dependent Claims 2-6, 8, 10-14, 17-18, 21, 25-26, 40-44, 46, 48-52 and 55-64

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1 and 20 under 35 U.S.C. § 103(a) as being unpatentable over White has been overcome and requests that the rejection be withdrawn. Additionally, claims 2-6, 8, 10-14, 17-18, 21, 25-26, 40-44, 46, 48-52 and 55-64 depend from independent claims 1, 20 and 39, respectively, and are, consequently, also respectfully submitted to be allowable.

Regarding claim 6, the Examiner states:

"With regard to claim 6, White teaches that the at least one client is capable of accessing, downloading and decoding **portions** of a media file (White: Paragraph [0014]. As the media file is being downloaded, at least a portion is being downloaded. **It is noted that there is no requirement in the claim that the portion cannot be the entire media file.**")

See the Final Office Action at page 5. The Examiner takes the position that White's two way synchronization teaches downloading the "entire media file", and that the meaning of "the entire media file" can be construed as meeting the requirement of "**portions** of a media file". The Applicant respectfully traverses the Examiner's

argument and points out that the word “entire” is, in fact, logically opposite to the meaning of “portion of”.

Therefore, based on the foregoing rationale, the Applicant maintains that White does not disclose or suggest “downloading and decoding **portions of the specific ones of the** media files,” as recited in claim 6 by the Applicant. Claim 21 is rejected for the same rationale as claim 6 by the Examiner, and is submitted to be allowable for the same rationale as discussed with respect to claim 6.

Regarding claim 26, the Examiner states:

“With regard to claim 26, White teaches: automatically accessing the media files on the server by the client in the car, ...(White: Paragraph [0034]); comparing the media files stored in the memory of the server with a list of media files stored in the memory of the car (White: Paragraph [0034]. The mobile server and home server are synchronized, meaning that a comparison of the media is made, and changes are determined that need to be made.); and downloading any media files in the server that are not in the memory in the car, if the memory in the car has sufficient storage space (White: Paragraph [0034]. The files can only be synchronized if there is enough space.)

See the Final Office Action at page 8. The Examiner is referred to the argument in claim 1 above that White’s two way synchronization does not disclose or suggest at least “downloading specific ones of the media files”. Furthermore, the Examiner also concedes that White does not disclose the claimed function below:

“removing media files in the memory in the car, then downloading media files in the server that are not in the memory in the car, if the memory in the car does not have sufficient storage space for more media files.”

See the Final Office Action at page 8. However, the Examiner takes Official Notice to allege that White's above functional deficiency is well known in the art. The Applicant respectfully traverses the Examiner's "Official Notice" argument, and points out that White's (non specific) two way synchronization downloading to produce **identical media files** in both servers, stipulates the necessity of a successful and impartial transfer of all the media files between the two servers. Based on this rationale, White's two-way synchronization would not have taken place if there is a lack of memory space in the mobile server 130 in the car. Based on White's non-specific two way downloading, there is simply no suggestion by White to **(selectively) remove certain media files to create storage space** in either the home media server 110 or the mobile server 130 in the car. In this regard, the Examiner's "Official Notice" argument that it would be obvious to suggest White teaches removing (certain) media files in the car is unsupported in White's disclosure.

Furthermore, regarding the Examiner's "Official Notice" argument, the Examiner is referred to MPEP at § 2142, which states:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. **If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.**

See MPEP at § 2142. Based on the above rationale, the Applicant maintains that the White does not disclose or suggest **"removing media files** in the memory in the car, **then downloading the specific ones of the media files in the server that are not in**

the memory in the car based on said particular location of said at least one client, if **the memory in the car does not have sufficient storage space** for more media files,” as recited in claim 26 by the Applicant. Claim 26 is therefore submitted to be allowable.

Regarding claim 29, the Examiner states:

“With regard to claim 29, White teaches the invention as substantially claimed except that the media files are accessed and downloaded from a specified directory on the server that is associated with the particular location of the client. However, Official Notice is taken that this functionality was well known in the art.... The suggestion/motivation for doing so would have been that White is concerned with synchronizing the mobile media server with a set of media (White: Abstract). ... There would be two ways to implement this. **The second way would be to simply have the set of media being all the media in a specific directory.** Clearly, the second method would require less resources, as the media would all be in a specified location, and there would be less problems with maintaining the table (i.e. if the file is present, it is to be copied.”

See the Final Office Action at page 9. The Examiner relies on Official Notice to reject claim 29. The traversal of Official Notice is maintained, as stated above with regard to claim 26. The Applicant points out that the Examiner’s second suggestion that White allegedly discloses “synchronizing the mobile media server with a set of media ...simply have the set of media being **all the media** in a specific directory,...(i.e. **if the file is present, it is to be copied**)”, is in fact, a further admission that White does not suggests or disclose “the **specific ones of the media files** are accessed and downloaded from a specified directory on the server ...,” as recited in claim 29 by the Applicant. Claim 33 is rejected for the same rationale as claim 29 by the Examiner, and

is submitted to be allowable for the same rationale as discussed with respect to claim 29.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2-6, 8, 10-14, 17-18, 21, 25-26, 40-44, 46, 48-52 and 55-64.

II. The Proposed Combination of White and Galensky Does Not Render Claims 7, 9, 15-16, 19, 22-24, 27-28, 45, 47 and 53-54 Unpatentable

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 20 and 39 under 35 U.S.C. § 103(a) as being unpatentable over White has been overcome and requests that the rejection be withdrawn. Additionally, since the additional cited reference (Galensky) does not overcome the deficiencies of White, claims 7, 9, 15-16, 19, 22-24, 27-28, 45, 47 and 53-54 depend from independent claims 1, 20 and 39, and are, consequently, also respectfully submitted to be allowable at least for the reasons stated above with regard to allowability of claim 1. The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 7, 9, 15-16, 19, 22-24, 27-28, 45, 47 and 53-54.

In general, the Final Office Action makes various Official Notice statements regarding claims 1-64 and the cited reference that are now moot in light of the above. Thus, the Applicant will not address such statements at the present time. However, the

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Applicant expressly reserves the right to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a rejection of any current or future claim).

CONCLUSION

Based on at least the foregoing, the Applicant believes that all claims 1-64 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Patent Agent at (312) 775-8093.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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